UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/765,085	01/18/2001	Tomoshi Hirayama	204685US6	6133

22850 7590 11/01/2005	EXAMINER
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314	VU, NGOC K

ART UNIT	PAPER NUMBER
2611	

DATE MAILED: 11/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>08 August 2005</u>.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-53</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) <u>24-33 and 37-53</u> is/are allowed.

6)☒ Claim(s) <u>1-23 and 34-36</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date~~_____~~.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

Response to Arguments

1.   Applicant's arguments filed 8/8/05 with respect to claims 1-53 have been considered but

are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

2.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

3.   Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Khoo et al.

(US 6,434747 B1) in view of Reynolds (US 6742183 B1).

Regarding claim 1, Khoo teaches an information providing system comprising:

a transmission server section (225) configured to transmit a continuous stream of

content data of a group of multimedia contents (media and advertising contents) including

prearranged combinations of program main body data (the customized media) and groups of

auxiliary materials (the advertising), the auxiliary materials including at least commercial data

(advertising commercials) with attributes (i.e., properties) (see col. 7, lines 20-26 and 29-35, 50-

54 and figure 2);

terminal sections (clients 235) configured to receive the continuous stream of contents

data transmitted from the transmission server section (receiving the media and advertising

contents at user device 235 from the server 225) (see col. 7, lines 20-26); and

said terminal sections being provided with an arrangement control function of preparing

a new arrangement by modifying the arrangement order to the contents data (rearranging order

the contents or modifying the contents) by processing the attribute data of each program main

body data and that of each auxiliary material of a program as separated from each other (for instance, by reading the properties of each media and advertising contents of a program) as well as the profile data of the user and that of the user device (the personal data of a particular user and of a particular user device) (see col. 7, lines 21-26; col. 5, lines 48-51; col. 11, lines 4-10).

Khoo does not teach the commercial data with attributes including at least an effective date. However, Reynolds discloses that advertisement control information includes presentation date and time to present the advertisement at a particular date and time (see col. 6, lines 37-41). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Khoo by including date and time in advertisement control information as disclosed by Reynolds in order to present the advertisement at a particular date and time.

Regarding claim 2, Khoo teaches providing the customized content in response to a request made on the basis of the result obtained by processing/reading the properties and the personal data (see col. 7, lines 37-54; col. 9, lines 42-47).

Regarding claim 3, Khoo teaches that the client device has a memory (within module 400) adapted to temporary replace the profile data with some other profile data (e.g., updating the personal data) (see col. 8, lines 18-23; col. 11, lines 10-15).

Regarding claim 4, Khoo teaches the features of each of the terminal sections (client 235) has a function of notifying the transmission server section (225) of the result of reproducing the contents data (updating the personal data) according to the new arrangement (e.g. adding, removing or rearrangement of the contents) prepared by means of the arrangement control function (see col. 11, lines 7-12). Khoo further teaches the features of the user may rearrange the customized media list including modifying the customized media and the customized

advertising, and the user may remove customized advertising by paying the content provider a

premium fee (see col. 5, lines 45-53).

Regarding claim 5, Khoo teaches an information terminal (235) configured to receive a

continuous stream of contents data (media and advertising contents) transmitted from a

transmission server section (225), said terminal sections being provided with an arrangement

control function of preparing a new arrangement by modifying the arrangement order of the

contents data (rearranging order the contents or modifying the contents), which includes

commercial data (advertising commercials) with attributes (i.e., properties) (see col. 7, lines 20-

26 and 29-35, 50-54 and figure 2), by processing the attribute data of each program main body

data and that of each auxiliary material of a program as separated from each other (for instance,

by reading the properties of each media and advertising contents of a program) as well as the

profile data of the user and that of the user device (the personal data of a particular user and of

a particular user device) (see col. 7, lines 21-26; col. 5, lines 48-51; col. 11, lines 4-10).

Khoo does not teach the commercial data with attributes including at least an effective

date. However, Reynolds discloses that advertisement control information includes presentation

date and time to present the advertisement at a particular date and time (see col. 6, lines 37-

41). Therefore, it would have been obvious to one of ordinary skill in the art at the time the

invention was made to modify the system of Khoo by including date and time in advertisement

control information as disclosed by Reynolds in order to present the advertisement at a

particular date and time.

Regarding claim 6, Khoo teaches providing the customized content in response to a

request made on the basis of the result obtained by processing/reading the properties and the

personal data (see col. 7, lines 37-54; col. 9, lines 42-47).

Regarding claim 7, Khoo teaches that the client device has a memory (within module 400) adapted to temporary replace the profile data with some other profile data (e.g., updating the personal data) (see col. 8, lines 18-23; col. 11, lines 10-15).

Regarding claim 8, Khoo teaches a function of notifying the transmission server section (225) of the result of reproducing the contents data (updating the personal data) according to the new arrangement (e.g. adding, removing or rearrangement of the contents) prepared by means of the arrangement control function (see col. 11, lines 7-12).

Regarding claim 9, Khoo teaches an information providing method comprising: transmitting a continuous stream of content data of a group of multimedia contents (media and advertising contents) including prearranged combinations of program main body data (the customized media) and groups of auxiliary materials (the advertising), the auxiliary materials including at least commercial data (advertising commercials) with attributes (i.e., properties), from a transmission server (225) (see col. 7, lines 20-26 and 29-35, 50-54 and figure 2); and

receiving the continuous stream of contents data at an information terminal (receiving the media and advertising contents at user device 235) and preparing a new arrangement by modifying the arrangement order to the contents data (rearranging order the contents) by processing the attribute data of each program main body data and that of each auxiliary material of a program as separated from each other (for instance, by reading the properties of each media and advertising contents of a program) as well as the profile data of the user and that of the user device (the personal data of a particular user and of a particular user device) (see col. 7, lines 21-26; col. 5, lines 48-51; col. 11, lines 4-10).

Khoo does not teach the commercial data with attributes including at least an effective date. However, Reynolds discloses that advertisement control information includes presentation date and time to present the advertisement at a particular date and time (see col. 6, lines 37-

41). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Khoo by including date and time in advertisement control information as disclosed by Reynolds in order to present the advertisement at a particular date and time.

Regarding claim 10, Khoo teaches providing the customized content in response to a request made on the basis of the result obtained by processing/reading the properties and the personal data (see col. 7, lines 37-54; col. 9, lines 42-47).

Regarding claim 11, Khoo teaches the features of the user may rearrange the customized media list including modifying the customized media and the customized advertising, and the user may remove customized advertising by paying the content provider a premium fee (see col. 5, lines 45-53).

4.   Claims 12-23 and 34-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Khoo et al. (US 6,434747 B1) in view of Reynolds (US 6742183 B1) and further in view of Hendricks et al. (US 5,600,364 A).

Regarding claim 12, Khoo teaches an information providing system comprising:

a transmission server section 225 configured to transmit a continuous stream of content data of a group of multimedia contents (i.e., media and advertising contents) including prearranged combinations of program main body data (i.e., the customized contents) prepared with information 226 annexed thereto and groups of auxiliary materials (i.e., the advertising), the auxiliary materials including at least commercial data (advertising commercials) with attributes (i.e., properties) (see col. 4, lines 59-65; col. 5, lines 29-39; col. 7, lines 20-26 and 29-35, 50-54 and figure 2);

terminal sections 235 having a function of receiving the continuous stream of contents

data transmitted from the transmission server section (receiving the media and advertising

contents at user device 235 from the server 225) (see col. 7, lines 20-26); and

a processing server section (within 225) configured to send the revision assisting

materials, if any, (the customized advertising contents) corresponding to the advertising

combined with the media content to be reproduced by one of clients 235 on the basis of the

information 226 (see col. 7, lines 22-36).

Khoo does not teach the commercial data with attributes including at least an effective

date. However, Reynolds discloses that advertisement control information includes presentation

date and time to present the advertisement at a particular date and time (see col. 6, lines 37-

41). Therefore, it would have been obvious to one of ordinary skill in the art at the time the

invention was made to modify the system of Khoo by including date and time in advertisement

control information as disclosed by Reynolds in order to present the advertisement at a

particular date and time.

Khoo does not teach transmitting sorting information and terminal ID information from

the terminal sections. However, Hendricks teaches that transmitting a polling response included

program access information and set top ID from set top terminals to a network controller (see

col. 27, lines 50-60 and figure 10a-10b). Therefore, it would have been obvious to one of

ordinary skill in the art at the time the invention was made to modify the system of Khoo by

transmitting program access information and set top ID from set top terminals to a network

controller as disclosed by Hendricks in order to allow provider to track the client's program

access history.

Regarding claim 14, Khoo as modified by Hendricks further shows that the polling response contains a return address identifying the location of the network controller (see Hendricks: figure 10b).

Regarding claims 13 and 16, the combined teachings of Khoo and Hendricks include that the customized advertising contains advertising commercials that are sequenced within the customized content in a predetermined order (see Khoo: col. 7, lines 32-35); and return the program access information contains event ID numbers and the set top ID to the network controller specified by the return address to allow the network controller ranking programs for a particular viewing period or time slot (see Hendricks: see figure 10b; col. 38, lines 45-49 and col. 38-39, lines 62-3).

Regarding claim 15, it must be understood that the client 235 includes memory for storing or recording the received contents such as the media/advertising contents and information 226 (see Khoo: figure 4; col. 11, lines 20-22; col. 8, lines 16-25; col. 7, lines 18-26).

Regarding claim 17, Khoo teaches an information terminal having:

a function of receiving the continuous stream of contents data transmitted from the transmission server section (receiving the media and advertising contents at user device 235 from the server 225) (see col. 7, lines 20-26);

a function of transmitting information 226 annexed to the program main body data and the auxiliary materials, the auxiliary materials including at least commercial data (advertising commercials) with attributes (i.e., properties) (see col. 4, lines 59-65; col. 5, lines 29-39; col. 7, lines 20-26 and 29-35, 50-54 and figure 2); and

a function of receiving the revision assisting materials, if any, (the customized advertising contents) corresponding to the advertising combined with the media content to be reproduced by one of clients 235 on the basis of the information 226 (see col. 7, lines 22-36).

Khoo does not teach the commercial data with attributes including at least an effective date. However, Reynolds discloses that advertisement control information includes presentation date and time to present the advertisement at a particular date and time (see col. 6, lines 37-41). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Khoo by including date and time in advertisement control information as disclosed by Reynolds in order to present the advertisement at a particular date and time.

Khoo does not teach transmitting sorting information and terminal ID information. However, Hendricks teaches that transmitting a polling response included program access information and set top ID from set top terminals to a network controller (see col. 27, lines 50-60 and figure 10a-10b). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Khoo by transmitting program access information and set top ID from set top terminals to a network controller as disclosed by Hendricks in order to allow provider to track the client's program access history.

Regarding claim 18, it must be understood that the client 235 includes memory for storing or recording the received contents such as the media/advertising contents and information 226 (see Khoo: figure 4; col. 11, lines 20-22; col. 8, lines 16-25; col. 7, lines 18-26).

Regarding claim 19, Khoo as modified by Hendricks further teaches sending back the program access information contains event ID numbers and the set top ID to the network controller specified by the return address to allow the network controller ranking programs for a particular viewing period or time slot (see Hendricks: see figure 10b; col. 38, lines 45-49 and col. 38-39, lines 62-3).

Regarding claim 20, see the similar interpretation of claim 17 above.

Regarding claims 21 and 23, see the similar interpretation of claims 13 and 16 above.

Regarding claim 22, see the similar interpretation of claim 14 above.

Regarding claim 34, Khoo teaches an information terminal device having:

a function of receiving the continuous stream of contents data transmitted from the

transmission server section (receiving the media and advertising contents at user device 235

from the server 225) (see col. 7, lines 20-26);

a function of recording the program main body data and the auxiliary materials received

by it (it must be understood that the client 235 includes memory for storing or recording the

received contents such as the media/ advertising contents and information 226 - see Khoo:

figure 4; col. 11, lines 20-22; col. 8, lines 16-25; col. 7, lines 18-26); and

a function of recording information 226 annexed to the program main body data and the

auxiliary materials, the auxiliary materials including at least commercial data (advertising

commercials) with attributes (i.e., properties) (see col. 4, lines 59-65; col. 5, lines 29-39; col. 7,

lines 20-26 and 29-35, 50-54 and figures 2 and 4; col. 11, lines 20-22; col. 8, lines 16-25).

Khoo does not teach the commercial data with attributes including at least an effective

date. However, Reynolds discloses that advertisement control information includes presentation

date and time to present the advertisement at a particular date and time (see col. 6, lines 37-

41). Therefore, it would have been obvious to one of ordinary skill in the art at the time the

invention was made to modify the system of Khoo by including date and time in advertisement

control information as disclosed by Reynolds in order to present the advertisement at a

particular date and time.

Khoo does not teach transmitting sorting information and terminal ID information.

However, Hendricks teaches that transmitting a polling response included program access

information and set top ID from set top terminals to a network controller (see col. 27, lines 50-60

and figure 10a-10b). Therefore, it would have been obvious to one of ordinary skill in the art at

the time the invention was made to modify the system of Khoo by transmitting program access information and set top ID from set top terminals to a network controller as disclosed by Hendricks in order to allow provider to track the client's program access history.

Regarding claims 35 and 36, Khoo teaches that the client 235 receives option sent from the server to change or modify the advertising content and updates the personal data if the client chooses to modify the content (see col. 11, lines 6-12; col. 5, lines 48-51).

Allowable Subject Matter

5.   Claims 24-33 and 37-53 are allowed.

6.   The following is a statement of reasons for the indication of allowable subject matter:

The prior art of the record fails to teach or fairly suggest the features of "a processing server section configured to detect any change to be made to the auxiliary materials combined with the selected program main body data and, upon detecting such a change, issuing an instruction for the change made to be made to said auxiliary materials to the related terminal section" as recited in claim 24; "a function of detecting any change to be made to the auxiliary materials combined with the program main body data selected by said terminal section on the basis of the sorting information and the terminal ID information received by it; and a function of issuing an instruction for the change to be made to the auxiliary materials upon detecting the change to be made" as recited in claim 37; "detecting any change to be made to the auxiliary materials combined with the selected program main body data, and upon detecting such a change, issuing an instruction for the change made to be made to said auxiliary materials to an information terminal" as recited in claim 44.

Conclusion

7.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ngoc K. Vu whose telephone number is 571-272-7306. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Grant can be reached on 571-272-7294. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private

PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ngoc K. Vu
Primary Examiner
Art Unit 2611

October 28, 2005